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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 10030568-1	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>December 18, 2007</u> Signature Typed or printed name <u>Gregory W. Osterloth</u>	Application Number 10/828,443	Filed April 20, 2004	
	First Named Inventor Richard L. Baer		
	Art Unit 2624	Examiner Stephen R. Koziol	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input type="checkbox"/> attorney or agent of record. Registration number _____</p> <p><input checked="" type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 <u>36,232</u></p> <p> Signature Gregory W. Osterloth Typed or printed name (303) 295-8205 Telephone number December 18, 2007 Date</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input type="checkbox"/> *Total of _____ forms are submitted.</p>			

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 10/828,443 Confirmation No. 4008
Applicant : Richard L. Baer
Filed : April 20, 2004
TC/A.U. : 2624
Examiner : Stephen R. Koziol

Docket No. : 10030568-1

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF

Sir:

In response to the Final Office Action of September 18, 2007, applicant has filed a "Notice of Appeal" and "Pre-Appeal Brief Request for Review" with this "Pre-Appeal Brief".

Claims 1-14, 17-28, 30, 32 and 33 remain in this application, all of which stand rejected, as discussed below.

1. Rejection of Claims 1-14, 17, 18, 22-28, 30 and 33 Under 35 USC 102(b)

Claims 1-14, 17, 18, 22-28, 30 and 33 stand rejected under 35 USC 102(b) as being anticipated by Janiak et al. (U.S. Patent Application Publication No. 2002/0030581 A1; referred to herein as "Janiak").

Claim 1 recites:

1. A biometric data card, comprising:

an image sensor for capturing an image of a biometric feature of a user of the biometric data card and producing first image data representing the image; a memory operable to store second image data; and
a processor in communication with said image sensor and said memory, said processor operable to perform a comparison of the first image data with the second image data, and, to generate, in response to the comparison,

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authentication information representative of an authentication of the user, wherein the processor is configured for transmitting the authentication information through a card interface in a terminal so as to authenticate the user to the terminal separate from said image sensor, said memory, and said processor.

(Emphasis added).

In rejecting claim 1, the Examiner asserts, in part, that:

...Janiak discloses a biometric data card (fig 1 [16]), comprising: an image sensor for capturing an image of a biometric feature of a user. . .(fig 1 [16], also, par. [0027]);. . .

9/18/2007 Final Office Action, p. 2., sec. 3.

Applicant respectfully disagrees. Janiak's element 16 is merely described as a "data card". See, Janiak, p. 2, par. [0027]. Janiak also teaches, in par. [0027], that:

...Data card 16 can come in any form that is capable of storing fingerprint data for an enrollee. An enrollee is a potential user of the device who has gone through an enrollment process, or the process of collecting biometric samples from a person and storing data from the biometric samples on the data card for comparison to the end user's biometric sample data. **Data card 16 can be an optically read card where data from a single (or multiple) fingerprint image(s) is/are contained within a 2D barcode symbol (such as PDF 417) printed on a plastic card.** This finger image data is capable of being optically read from the data card. **Data card 16 can also be, for example, a memory card that includes a memory chip 18 embedded within the card.** Typically, the memory or smart card is capable of storing more information than the optically read data card, and also permits the writing of transactional data to the chip while the data card is inserted. The data can be downloaded later to another central location for the particular application. The data can then be erased from the memory card, thereby freeing up space for additional information storage. **Additionally, the data card can be a smart card, where transactional data can be collected and stored, but it can also be processed and used directly by the smart card in particular applications. Therefore, a card that is read-only, read-and-write, or read-write-transactional is contemplated by data card 16.**

(Emphasis added).

Nowhere in the preceding excerpt (or elsewhere) does Janiak indicate that the data card 16 can, should or may comprise an image sensor. Rather, Janiak only indicates that the data card 16 can be 1) a card having fingerprint data encoded on a surface thereof, in a 2D barcode symbol; 2) a card having a memory for storing fingerprint data; or 3) a smart card that is capable of collecting and storing transactional data. It is the "smart card" version of the data card 16 that is the subject of debate between applicant and the Examiner.

The Examiner asserts that, because Janiak's smart card can collect and store transactional data (which presumably includes fingerprint data), it necessarily follows that Janiak's smart card would have to carry an image sensor thereon. Otherwise, the Examiner asserts, the smart card would have no way to "collect" fingerprint data. Applicants respectfully, but strongly, disagree.

Janiak does not teach, suggest or imply that a smart card should comprise an image sensor for collecting fingerprint data. Applicants assert that there are many ways that a smart card can "collect" data - one of which is by passively receiving the data (or actively requesting the data) and storing the data in memory. This is the way that most smart cards are used/configured.

Applicants believe that receiving or requesting fingerprint data, and then storing or processing the fingerprint data, is all that Janiak contemplates (and all that Janiak teaches or suggests to one of ordinary skill in the art). Applicants belief is supported by the fact that Janiak does not disclose any use of the data card 16 apart from a host device (such as the biometric device 10 or "another central location"; see, FIG. 1 and par. [0027]). This "host device" (e.g., the biometric device 10) is the only item disclosed by Janiak that carries a "fingerprint sensor 26". See, FIG. 1.

It is also worthy to note that the data card 16 shown in Janiak's FIG. 1 comprises the optional memory chip 18 mentioned in paragraph [0027]. This memory chip 18 is the same memory that Janiak refers to, interchangeably, as a "memory or smart card". See, paragraph [0027]. Given that the data card 16 with memory chip 18 is shown to be inserted into the biometric device 10 in FIG. 1, and given that only the biometric device 10 has a fingerprint sensor 26, applicant believes that Janiak failed to contemplate the placement of an image sensor on the data card

16. Furthermore, applicant does not believe that Janiak, taken together with "general knowledge" in the art, would motivate one of ordinary skill in the art to contemplate moving the fingerprint sensor 26 to the data card 16. Nor would Janiak, coupled with "general knowledge", motivate one of ordinary skill in the art to place a duplicate fingerprint sensor 26 on the data card 16.

For the above reasons, applicant does not believe that the Examiner has set forth a prima facie basis for rejecting claim 1 (either under 35 USC 102(b), or under 35 USC 103(a)). Applicant therefore requests the allowance of claim 1.

Although applicant believes that various other claims are allowable for various other reasons, applicant also believes that claims 2-14, 17, 18, 22-28, 30 and 33 are allowable for reasons similar to why claim 1 is believed to be allowable. As a result, and to limit the issues that need to be considered during the Pre-Appeal Conference, applicant limits this argument to the above facts and observations.

2. Rejection of Claims 19-21 and 32 Under 35 USC 103(a)


Claims 19-21 and 32 stand rejected under 35 USC 103(a) as being unpatentable over Janiak as applied to claim 11 above, and further in view of Angelo (U.S. Patent No. 6,182,892 B1).

Claims 19-21 and 32 are believed to be allowable, at least, because each of these claims depends from claim 11 or claim 26, because claims 11 and 26 are believed to be allowable for the reasons set forth in section 1 of this Pre-Appeal Brief, and because Angelo fails to teach that which is missing from Janiak, as argued in section 1 of this Pre-Appeal Brief.

3. Conclusion

In light of the amendments and remarks provided herein, applicant respectfully requests the issuance of a Notice of Allowance.

Respectfully submitted,
HOLLAND & HART, LLP

By: 

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